

REMARKS/ARGUMENTS

In the Office Action, the Examiner noted that claims 1-20 are pending in the application and that claims 1-20 are rejected. By this response, claims 1, 4, 8, 10, 12, 18 and 19 have been amended. Thus, claims 1-20 remain pending in this application.

Rejections Under 35 U.S.C. §112

Claims 1-11 and 18 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Claims 1 and 18 (as well as independent claim 12) have been amended to include an "embedded web server".

It is well known to one of ordinary skill in the field that an embedded web server comprises web server software that is embedded within a hardware device such as a print server. The embedded web server is widely used in a myriad of devices, because it allows access to software by way of any web browser, typically in order to configure a device or obtain reports (*Computer Desktop Encyclopedia*, 9th ed., Alan Friedman; Osborn/McGraw-Hill, ©2001).

In order to establish a *prima facie* case of non-enablement with respect to the disclosure of a patent application, the Examiner must provide: 1) a rational basis as to a) why the disclosure does not teach or b) why to doubt the objective truth of the statements in the disclosure that purport to teach; 2) the manner and process of making and using the invention; 3) that corresponds in scope to the claimed invention; 4) to one of ordinary skill in the pertinent technology; 5) without undue experimentation; and 6) dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

In order for a rejection under first paragraph of Section 112 to be proper, the Examiner must provide evidence from the application supporting each of these elements. It is well established that the applicant need not disclose every minute detail for an application to be enabling. In fact, the drawings alone may be sufficient for enablement. If the drawings in conjunction

with the rest of the specification enable a person skilled in the art to make a selection and practice the claimed invention with only a reasonable degree of routine experimentation, then enablement has been established. The specification need not recite details of the claims where one of ordinary skill in the art would consider these details obvious. An embedded web server in a computer peripheral device is taught to sufficient scope for one of ordinary skill in the pertinent technology (without undue experimentation).

Furthermore, when an invention involves multiple technologies, enablement is judged from the view of a person of ordinary skill in each separate technology. When an invention is more complicated because of the combination of separate technologies, an Examiner may not assert that the application must include a more detailed explanation of how to make and use it (see *In re Naquin*, 398 F.2d 863, 158 USPQ 317 (C.C.P.A. 1968)).

The specification need not describe or enable the invention to a layperson. Rather, it need only describe the invention to one of ordinary skill in the art. "Requiring inclusion in the patent of known scientific/technological information would add an imprecise and open-ended criterion to the content of patent specifications, could greatly enlarge the content of patent specifications and unnecessarily increase the cost of preparing and prosecuting patent applications, and could tend to obfuscate rather than highlight the contribution to which the patent is directed. A patent is not a scientific treatise, but a document that presumes a readership skilled in the field of the invention." See *Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 56 USPQ2d 1332, 136 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 1019 (2001) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Whether an invention requires undue experimentation is based on many factors including the quantity of experimentation necessary, the nature of the invention, the state of the prior art, the relative skill of those in the art, etc.

Applicant asserts that amended claims 1-11 and 18 comply with the enablement requirement and that rejection under 35 U.S. § 112, first paragraph, is overcome. Action to that end is respectfully requested.

Claims 1-3, 7 and 9-20 are rejected under 35 U.S.C. §112, second paragraph, as based on a disclosure which is not enabling. Claims 1, 12, 18 and 20 have been amended to include an "embedded web server". Accordingly, the rejections under 35 U.S.C. §112, second paragraph, to claims 1-3, 7 and 9-20 is believed to be overcome and the claims are believed to be allowable. Action to that end is respectfully requested.

Rejections Under 35 U.S.C. §103

Claims 1-4, 8-10, 12, 13, and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* (U.S. 2002/0042747 A1) in view of *Yoda* (U.S. Patent 5,515,268).

Claims 1-4, 8-10, 12, 13 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* (U.S. 2002/0042747 A1) in view of *Yoda* (U.S. Patent 5,515,268). Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* (U.S. 2002/0042747 A1) in view of *Yoda* (U.S. Patent 5,515,268) and further in view of *Hartman, et al.* (U.S. Patent No. 5,960,411) and *Kageyama* (U.S. Patent No. 6,333,790 B1). Claims 14-18 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* (U.S. 2002/0042747 A1) in view of *Yoda* (U.S. Patent 5,515,268) and further in view of *Kageyama* (U.S. Patent No. 6,333,790 B1) and Official Notice.

With respect to the obviousness rejection of claims 1-3, 12, 13 and 19, the Examiner asserts that *Istvan* (U.S. 2002/0042747 A1) teaches a computer peripheral device having a messaging system communicating with a personal computer. The Examiner then asserts that *Istvan* does not teach a reseller web server having a messaging system communicating with a personal computer and configured to capture customer preferences from a customer accessing the reseller web server to order consumables via the computer peripheral device. The Examiner then states that *Istvan* teaches that a user may order ink refill products via the communication device by shopping online. The Examiner next asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the online merchant in the invention of *Istvan* to be a reseller. The Examiner claims that one of ordinary skill in the art would have been motivated to do so in order to have the user visit

a web site that had the item the user was interested in buying. As stated by the Examiner, *Istvan* does not teach that the online merchant captures customer preferences. The Examiner then cites *Yoda* (U.S. Patent 5,515,268) for teaching an apparatus for computer-assisted shopping wherein a remote vendor system captures a user's personal preferences. The Examiner then states it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of *Yoda* into the apparatus of *Istvan*. One of ordinary skill in the art would be motivated to do so in order to provide quicker and better services to customers as taught by *Yoda*. As also stated by the Examiner, *Istvan* and *Yoda* do not teach that a device-manufacturer web server communicates with the reseller web server and receives customer preferences from the reseller web server. The Examiner then states that it would have been obvious to one of ordinary skill in the art to do this and that one of ordinary skill in the art would have been motivated to do so in order to allow the reseller or the manufacturer to have business-to-business relationships.

Applicant respectfully disagrees with the Examiner's assertion. There is no teaching or suggestion to combine or modify *Istvan* and *Yoda* for such stated purpose. Furthermore, *Istvan* merely teaches that a user may order ink refill products by performing online shopping. This is vastly different than the claimed recitation of independent claims 1, 12, and 19. By way of example, independent claim 1 has a computer peripheral device with a messaging system that communicates with a personal computer. The device-manufacturer website communicates with the reseller web server and the computer peripheral device. The device-manufacturer web server is operative to receive customer preferences from the reseller web server and forward the customer preferences to the computer peripheral device using a messaging address for the computer peripheral device. Nowhere is this limitation taught or suggested by *Istvan* in combination with *Yoda*.

In order to establish a *prima facie* case of obviousness, the Examiner must provide: 1) one or more references; 2) that were available to the inventor and; 3) that teach; 4) a suggestion to combine or modify the references; 5) the combination or modification of which would appear to be

sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Here, the Examiner has failed to establish all of the elements. The Examiner has not shown a case of *prima facie* obviousness pursuant to the arguments presented above. Accordingly, Applicant asserts that obviousness rejection of claims 1-20 has been overcome.

With reference to claims 4, 8 and 9, the Examiner asserts that *Istvan* teaches a computer peripheral device that forwards customer preferences to a personal computer via a messaging system, and that *Istvan* does not teach that the preferences are sent to the web browser of the personal computer. The Examiner then asserts that *Istvan* teaches that a personal computer has a web browser, and that it would be obvious to one of ordinary skill at the time the invention was made to deliver the information to the web browser of the personal computer. The Examiner also acknowledges that *Istvan* does not teach a computer peripheral device having an embedded web browser, but that it would have been obvious to one of ordinary skill in the art to incorporate an embedded web server in the peripheral device of *Istvan*. Accordingly, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the prior art to obtain the invention as specified in the claims. Applicant respectfully disagrees. The devices of *Istvan* and *Yoda* would require a substantial reconstruction and redesign of the elements as shown in *Yoda* as well as a change in the basic principle under which the *Yoda* construction was designed to operate (see *In re Rattie*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (CCPA 1959). Accordingly, the proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified. Accordingly, the teachings of the references are not sufficient to render the claims *prima facie* obvious. More particularly, the principles of operation of the prior art apparatus of *Istvan* would be modified by incorporating the *Yoda* teachings of an apparatus for computer-assistant shopping wherein a remote vendor system captures users' personal preferences. *Istvan* does not teach a reseller web server having a messaging system communicating with a personal computer that is configured to capture customer preferences from a customer accessing the reseller web server to order consumables via the computer peripheral device. The addition of a remote vendor system for

capturing users' personal preferences would require a substantial reconstruction and redesign of the elements shown in *Istvan* as well as a change in the basic principles under which the *Istvan* construction was designed to operate.

More particularly, the Examiner asserts that *Istvan* teaches the computer peripheral device forwards customer preferences to the personal computer via the messaging system. The Examiner notes that *Istvan* does not teach the preferences are sent to the web browser of the personal computer. However, the Examiner notes that *Istvan* teaches a personal computer having a web browser, and that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to deliver the information to the web browser of the personal computer, with one of ordinary skill in the art being motivated to do so to provide the user with data using a well-known, user-friendly, graphical interface. Essentially, the Examiner is asserting that a different communication system be incorporated into *Istvan* from *Yoda*. The Examiner notes that one of ordinary skill in the art would have expected Applicant's invention to perform equally well with the communication system disclosed by *Istvan*. However, the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified. Accordingly, the teachings of the references are not sufficient to render the claims *prima facie* obvious.

With respect to claim 10, the Examiner asserts that *Istvan* and *Yoda* do not teach that customer preferences include consumable order information, and the Examiner asserts that this limitation is not functionally involved in the elements of the recited apparatus. However, claim 10 has been amended to further clarify the invention at hand. Accordingly, claim 10 is believed to be allowable over the combination of *Istvan* and *Yoda*, and action to that end is respectfully requested.

The Examiner has rejected claims 5 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Istvan* in view of *Yoda*, and further in view of *Hartman, et al.* The Examiner has asserted that *Istvan* and *Yoda* do not teach that a web browser generates a consumable order message incorporating customer preferences and forwards the consumable order messaging customer preferences to a reseller to order a consumable that matches the customer

preference or that the web server captures customer profile data. The Examiner cites *Hartman, et al.* as teaching an apparatus for online ordering wherein a web browser generates a consumable order message incorporating the customer preferences and forwards the consumable order message and customer preferences to an online merchant to order a consumable that matches the customer preference and further captures customer profile data. The Examiner asserts that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of *Hartman, et al.* into the apparatus of the cited prior art. The Examiner asserts that one of ordinary skill in the art would have been motivated to do so in order to help facilitate repeat orders. Applicant respectfully disagrees.

More particularly, the suggested combination of *Hartman, et al.* with *Yoda* and *Istvan* would require substantial reconstruction and redesign of the elements shown in *Istvan* and *Yoda*, as well as changes in the basic principle under which the *Istvan* reference (as well as the *Yoda* reference) construction was designed to operate. Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, the teachings of the references are not sufficient to render the claims *prima facie* obvious. More particularly, the incorporation of an online ordering system from *Hartman, et al.* into the personal computer and web browser of *Istvan* would change the principle of operation of the prior art. Accordingly, the rejections to claims 5 and 11 are not believed to provide a *prima facie* case of obviousness. Accordingly, such rejections are believed to be overcome and action to that end is respectfully requested.

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* in view of *Yoda*, and further in view of Official Notice. The Examiner has asserted that Official Notice is taken that it is old and well-known in the art for a web page, residing on a web server communicating with a plurality of entities, to include a link to another entity. The Examiner asserts that it would have been obvious to incorporate this feature in the invention of *Istvan* and *Yoda*. Applicant respectfully disagrees. Applicant asserts that the proposed modification of the "Official Notice" into the primary references of *Istvan* and *Yoda* would change the principle of operation of *Istvan* (as well as

Yoda), and that the teachings of the references are not sufficient to render the claims *prima facie* obvious.

The Examiner has asserted that claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* in view of *Yoda* and further in view of *Hartman, et al.* and *Kageyama*. The Examiner asserts that the cited prior art does not teach automatically generating a consumable order message in response to notification to replenish a consumable. The Examiner then asserts that *Kageyama* teaches this limitation, and that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of *Kageyama* into the set of prior art. The Examiner asserts that one of ordinary skill in the art would have been motivated to do so in order to automate the transaction. Applicant respectfully disagrees. Applicant asserts that the proposed modification or combination of the prior art teaching of *Kageyama* (namely, the automatic generation of a consumable order message in response to a notification to replenish the consumable) would change the principle of operation of the prior art invention of *Istvan* (as well as *Yoda*, and further as well in view of *Hartman, et al.*) as previously argued. Accordingly, the Applicant asserts that a *prima facie* case of obviousness has not been provided by the Examiner with respect to claim 6, and such claim is believed to be allowable over the prior art of record. Accordingly, action to that end is respectfully requested.

Claims 14-18 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan*, in view of *Yoda*, and further in view of *Kageyama*, as well as in view of Official Notice. The Examiner notes that *Istvan* and *Yoda* do not teach submitting ordering information in a messaging address from a personal computer to a device manufacturer server indicating that a consumable needs to be ordered for their computer peripheral device at the messaging address. The Examiner asserts that *Kageyama* teaches such limitation, and that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of *Kageyama* into the cited prior art. The Examiner asserts that the motivation to do so would be in order to automate the transaction. The Examiner acknowledges that the cited prior art does not teach (a) that the manufacturer server is a web server, or

(b) forwarding the ordering information and the messaging address to a reseller web page. However, the Examiner then takes Official Notice that it is old and well known in the art to configure a server as a web server. The Examiner then asserts it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a web server into the cited prior art. The motivation to do so would be in order to handle and process web-based interactions and transactions. The Examiner also asserts it would have been obvious to forward the order information and the messaging address to a reseller web page. The motivation to do this would be in order to have the user visit a web site that had the item the user was interested in buying. The Examiner notes that the cited prior art also does not teach that the device manufacturer web server includes a reseller selection page. The Examiner also takes Official Notice that it is old and well known in the art for a web page residing on a web server communicating with a plurality of entities to include a link or any other data. The Examiner then asserts it would have been obvious to incorporate this feature into the invention of the cited prior art. The motivation to do so would be to provide a user with the convenience of easily moving around the World Wide Web. Even furthermore, the Examiner takes additional Official Notice that the use of shopping cart and data stream is old and well known in the art. The Examiner then asserts it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to support real-time, online transactions. The Applicant respectfully disagrees.

The Examiner has taken Official Notice with respect to three items herein; namely, (1) the configuration of a server as a web server; (2) the provision of a web page, residing on a web server communicating with a plurality of entities, to include a link or any other data; and (3) the use of a shopping cart and data stream. Furthermore, Applicant argues that the provision of *Kageyama* as well as the three identified Official Notice provisions would change the principle of operation of the prior art invention being modified, and the teachings of the references are not sufficient to render the claims *prima facie* obvious. Accordingly, a *prima facie* case of obviousness has not been

identified with respect to claims 14-18 and 20. Hence, Applicant asserts that such claims are allowable. Accordingly, action to that end is respectfully requested.

Withdrawal of these rejections is respectfully requested.

CONCLUSION

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

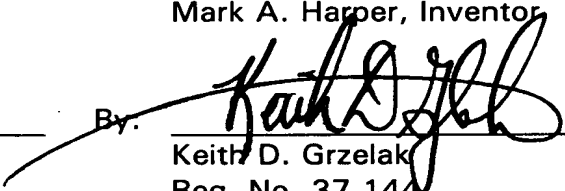
Respectfully submitted,

Mark A. Harper, Inventor

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